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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,160	01/28/2004	Haruo Yoshida	248138US6	2145

22850 7590 02/22/2007  
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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COLEMAN, VANESSA V

ART UNIT	PAPER NUMBER
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2609

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	02/22/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 02/22/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

**Office Action Summary****Application No.**

10/765,160

**Applicant(s)**

YOSHIDA ET AL.

**Examiner**

Vanessa (Brandi) Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/23/06, 1/26/07</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

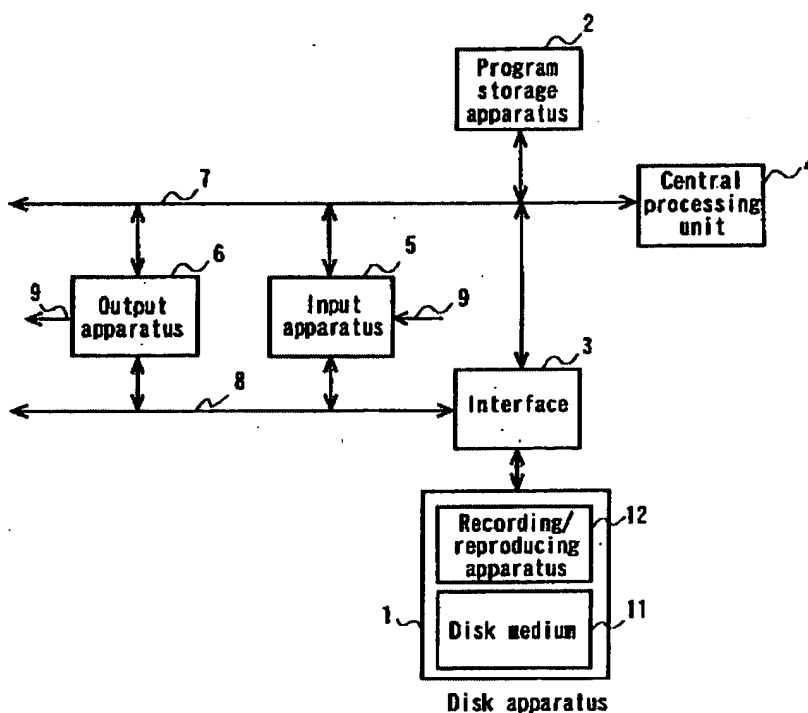
1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuno, et al, US Patent Number US 6,378,031 (hereinafter Kuno).

**F I G. 1**



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FIG. 2

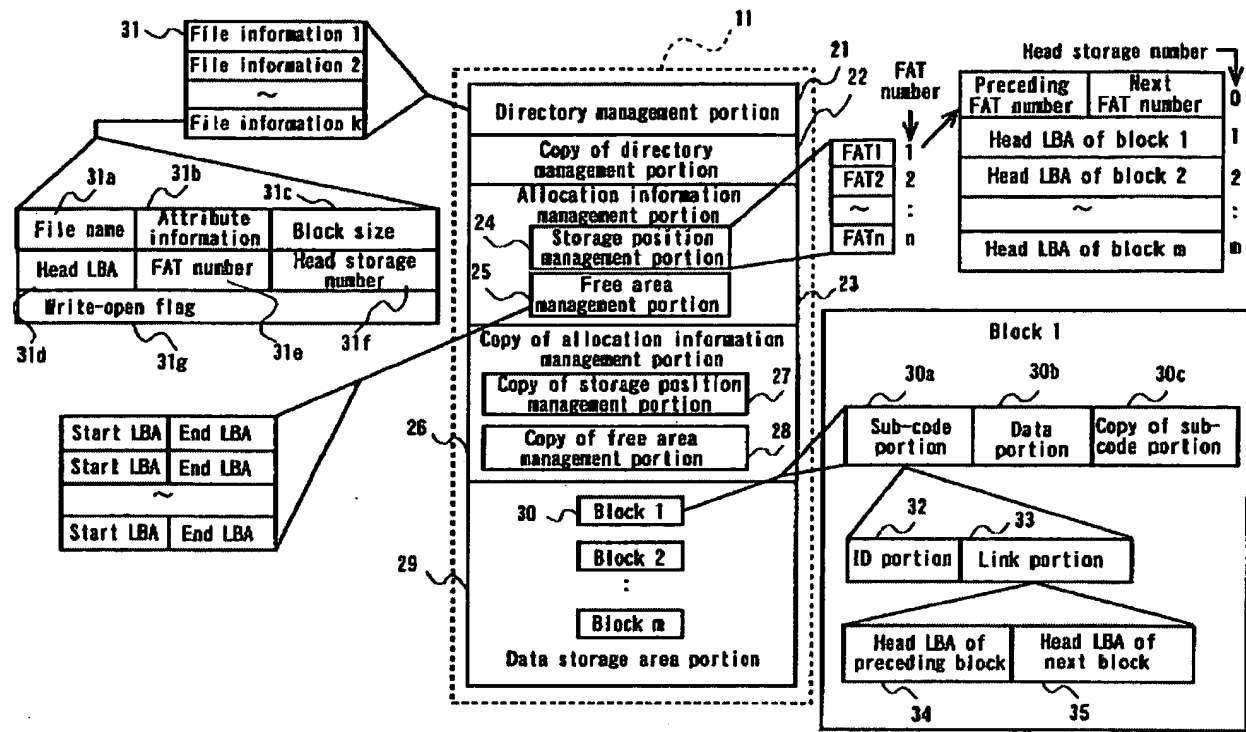


FIG. 3

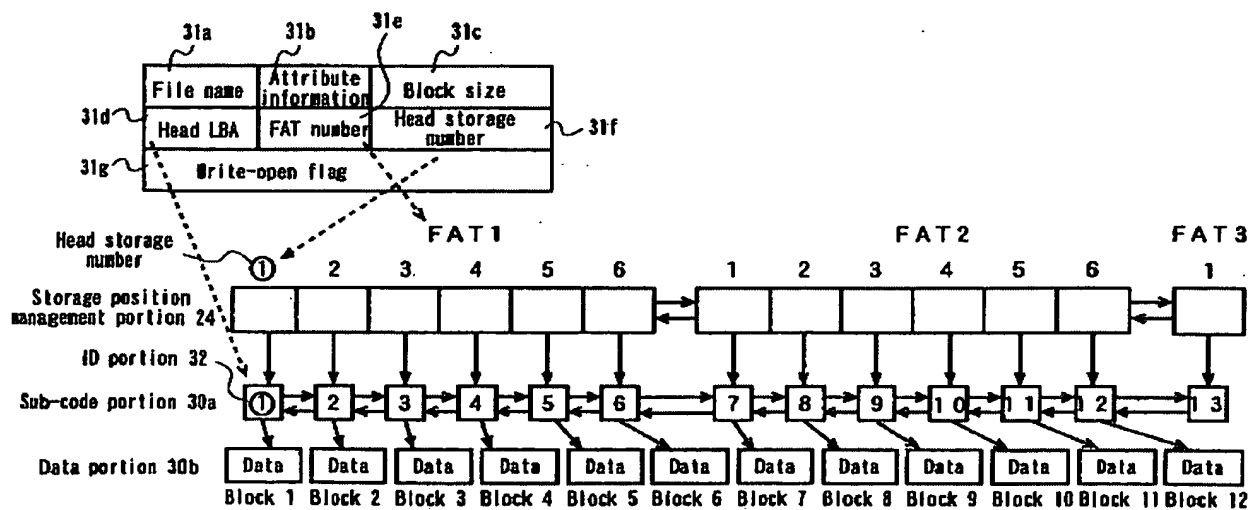
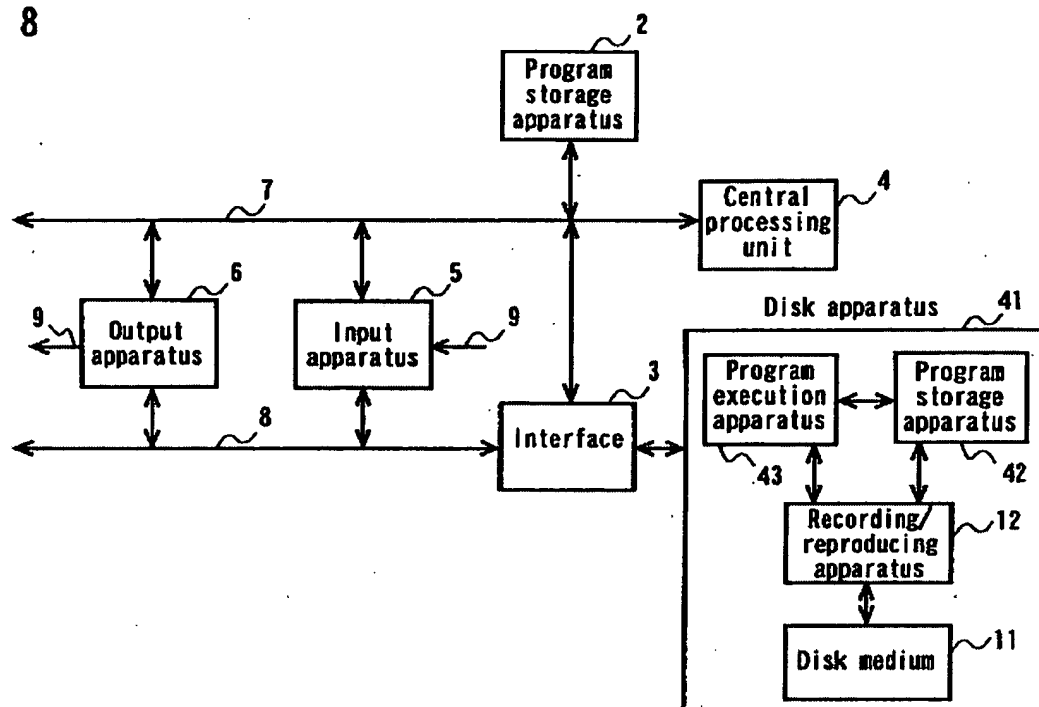


FIG. 8



For Claim 1 Kuno discloses:

A recording apparatus (data processing apparatus; see Fig. 1, Col. 7 lines 45-67, Col. 8 lines 1-13) for generating an index file (file information 31; see Figs 2 and 3; Col. 8 line 52) for each content file to be recorded to a recording medium (disk medium 11; see Fig. 1), the index file associating attribute information allocated to each content file with real data of said each content file (items 31a-31g; see Figs 2 and 3; Col. 8 line 52, Col. 9 lines 48-67, Col. 10 lines 1-9) and recording the generated index file to the recording medium (see Fig 4, Step S3; Col. 12 lines 33-38, Col. 13 lines 31-55).

In reference to the flag claimed by applicant, Kuno discloses a process of the data processing apparatus of creating and writing a file to the disk medium 11 (see Col. 11 lines 65-67, Col. 12) that entails designating a block size of the file to a central processing unit 4 (Col. 12 lines 11-15), where the block size is later compared to information about free area on the disk; the results of the comparison determining whether to proceed with recording of the data (Col. 12 lines 24-31). Kuno further discloses that the start logical block address (LBA) of that free area is recorded as the head LBA 31d in the file information 31 (Col. 12 lines 38-41). Thus, Kuno discloses applicant's claimed flag in that the start LBA is written by the central processing unit 4 only in the case that the free area is larger than the designated block size, which signifies that the data processing apparatus can proceed with recording the file and can be interpreted as an indication of the recording state; the start LBA indicates the location of an area to which the file may be recorded; and all of the processes are carried out prior to recording the file itself (see Col. 12, lines 57-59).

It is to be noted that Kuno meets all of the structural limitations of a recording apparatus, however, referring to paragraph 2114 of the MPEP, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation

of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

For Claims 5 and 6, the apparatus of Kuno inherently possesses applicant’s claimed method for generating an index file.

For Claim 2 Kuno discloses:

The start LBA of the free area is recorded in relation to all free areas because the data processing apparatus manages the free area information of the entire disk (see Fig. 2; also Col. 9 lines 6-7).

For Claim 3 Kuno discloses:

A recording apparatus (data processing apparatus; see Fig. 1, Col. 7 lines 45-67, Col. 8 lines 1-13) for generating an index file (File information 31; see Figs 2 and 3; Col. 8 line 52) for each content file to be recorded to a recording medium (Disk medium 11; see Fig. 1), the index file associating attribute information allocated to each content file with real data of said each content file (features 31a-31g; see Figs 2 and 3; Col. 8 line 52, Col. 9 lines 48-67, Col. 10

lines 1-9) and recording the generated index file to the recording medium (see Fig 4, Step S3; Col. 12 lines 33-38, Col. 13 lines 31-55).

In reference to the flag claimed by applicant, Kuno discloses a process of the data processing apparatus of creating and writing a file to the disk medium 11 (see Col. 11 lines 65-67, Col. 12) that entails designating a block size of the file to a central processing unit 4 (Col. 12 lines 11-15), where the block size is later compared to information about free area on the disk; the results of the comparison determining whether to proceed with recording of the data (Col. 12 lines 24-31). Kuno further discloses that the start logical block address (LBA) of that free area is recorded as the head LBA 31d in the file information 31 (Col. 12 lines 38-41). Thus, Kuno discloses applicant's claimed flag, in that the start LBA is written by the central processing unit 4 only in the case that the free area is larger than the designated block size, which signifies that the data processing apparatus can proceed with recording the file and can be interpreted as an indication of the recording state; the start LBA indicates the location of an area to which the file may be recorded; the central processing unit 4 retrieves the free area information about the disk before recording can begin, which can be considered a search for free area; and all of these processes are carried out prior to recording the file itself (see Col. 12, lines 57-59).

It is to be noted that Kuno meets all of the structural limitations of a recording apparatus, however, referring to paragraph 2114 of the MPEP, while features of an apparatus may be recited either structurally or functionally, claims



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directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429,1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

For Claims 7 and 8, the apparatus of Kuno inherently possesses applicant's claimed method for generating an index file.

For Claim 4 Kuno discloses:

The recording apparatus (data processing apparatus), wherein the information adding unit (central processing unit 4) newly records the index file (information file 31) having the attribute information (items 31a-31g) to which the flag (head LBA 31d) generated in accordance with the searched-out free area is added (see Col. 12 lines 31-54), to the recording medium (disk medium 11).

**Conclusion**

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tomita, Masami	US 6,031,806 A
Sasaki, Yoshiyuki	US 2004/0090886 A1
Koseki, Youichi	US 2004/0125719 A1
Kawamae et al.	US 2004/0233803 A1
Kiyama et al.	US 2005/0157599 A1

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanessa (Brandi) Coleman whose telephone number is (571) 272-9081. The examiner can normally be reached on Monday thru Friday 7:30-5 EST, First Friday off.

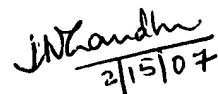
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jayprakash Ghandi can be reached on (571) 272-9820. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Vanessa Coleman  
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VC

Handwritten signature of Jayprakash Gandhi, dated 2/15/07.

JAYPRAKASH GANDHI  
SUPERVISORY PATENT EXAMINER